

ESTTA Tracking number: **ESTTA580784**

Filing date: **01/08/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|--|
| Name | TIERRA DEL SOL FOUR WHEEL DRIVE CLUB |
| Granted to Date of previous extension | 01/08/2014 |
| Address | 8812 Diamondback Drive Santee, CA 92071 UNITED STATES |
| Attorney information | Gary L. Eastman Eastman & McCartney, LLP 401 W. A Street, Suite 1785 SAN DIEGO, CA 92101 UNITED STATES gary@eastmanmccartney.com, docket@eastmanmccartney.com Phone:619-230-1144 |

Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 85899999 | Publication date | 09/10/2013 |
| Opposition Filing Date | 01/08/2014 | Opposition Period Ends | 01/08/2014 |
| Applicants | SIGNS, HEATHER 15848 Broad Oaks Rd El Cajon, CA 92021 USX SIGNS, LORI A 15848 BROAD OAKS RD EL CAJON, CA 92021 USX | | |

Goods/Services Affected by Opposition

Class 025. First Use: 2002/00/00 First Use In Commerce: 2002/00/00
All goods and services in the class are opposed, namely: Hats; headwear; hooded sweatshirts; jackets; shirts; sweatshirts; tank-tops; tops

Grounds for Opposition

| | |
|--|---|
| False suggestion of a connection | Trademark Act section 2(a) |
| Geographic indication which, if used on or in connection with wine or spirits, identifies a place other than the origin of the goods | Uruguay Round Agreements Act section 2(9) |
| Priority and likelihood of confusion | Trademark Act section 2(d) |

| | |
|--|---|
| The mark is merely descriptive | Trademark Act section 2(e)(1) |
| The mark is primarily geographically descriptive | Trademark Act section 2(e)(2) |
| Dilution | Trademark Act section 43(c) |
| <i>Torres v. Cantine Torresella S.r.l.Fraud</i> | 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986) |
| Genericness | Trademark Act section 23 |

Mark Cited by Opposer as Basis for Opposition

| | | | |
|---------------------------------------|--|------------------|------|
| U.S. Application/ Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | Ocotillo Wells | | |
| Goods/Services | four wheel drive events, and related clothing and paraphernalia. | | |

| | |
|-------------|--|
| Attachments | OcotilloWells_Opposition.pdf(1520277 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|-----------------------|
| Signature | /**Gary L. Eastman**/ |
| Name | Gary L. Eastman |
| Date | 01/08/2014 |

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TIERRA DEL SOL FOUR WHEEL DRIVE CLUB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD**

TIERRA DEL SOL FOUR WHEEL
DRIVE CLUB

Opposer,

v.

LORI A. SIGNS,

Applicant.

Application Serial No. 85/899999

MARK: OCOTILLO WELLS

NOTICE OF OPPOSITION

Tierra Del Sol Four Wheel Drive Club (“Opposer”) is a California corporation duly organized and existing under the laws of the State of California, with a principal place of business at 8812 Diamondback Drive, Santee, California 92071. Opposer believes that it will be damaged by the registration of U.S. Trademark Application Serial No. 85/899999 for the mark “OCOTILLO WELLS” covering “hats; headwear; hooded sweatshirts; jackets; shirts; sweatshirts; tank-tops” in Class 25 (“the Application”) filed by Lori A. Signs (“Applicant”) and hereby opposes the same.

1 In support of this Opposition, Opposer alleges the following:

2 **Opposer and its Prior Use of the OCOTILLO WELLS Mark**

3 1. Opposer is a California corporation duly organized and existing under
4 the laws of the State of California, with a principal place of business at 8812
5 Diamondback Drive, Santee, California 92071.

6 2. Opposer's origins date back to the late 1940s-50s, when a small group
7 of adventurous men became enamored with the use of military-style jeeps in the
8 mountainous back country and desert of Southern California, eager to see what the
9 challenging countryside had to offer.

10 3. Eventually the membership evolved into a club named Tierra Del Sol
11 Four Wheel Drive Club (i.e. Opposer herein), which was incorporated in 1962 as a
12 non-profit organization.

13 4. Since the late 1940s-50s, Opposer has grown from a mere handful of
14 men to a thriving, national four wheeling community, united to celebrate
15 exploration and adventure and support off-roading policies at the state and national
16 level. Today, Opposer is a premier family outdoor recreation club that attracts
17 members from throughout the country.

18 5. For over 50 years, Opposer has been hosting outdoor family four
19 wheeling events, commonly known as the "Tierra Del Sol Desert Safari" or "TDS
20 Desert Safari" for short, in the Truckhaven Hills area of the North Ocotillo Wells
21 State Vehicular Recreation Area ("SVRA").

22 6. In 2014, Opposer will be celebrating its 52nd TDS Desert Safari event
23 at Truckhaven in the North Ocotillo Wells SVRA.

24 7. Opposer's TDS Desert Safari event at Truckhaven in the North
25 Ocotillo Wells SVRA is the largest four wheeling event on the west coast,
26 attracting off-road enthusiasts of all ages and from all over the country and
27 featuring hundreds of vendors and retailers from the off-road industry.

28 8. For over 50 years, Opposer has been using the OCOTILLO WELLS
mark in commerce in connection with its events, and the advertising, organizing,
Notice of Opposition

1 producing, and hosting four wheeling events in in the Truckhaven Hills area of the
2 North Ocotillo Wells SVRA in Southern California.

3 9. For at least 30 years, Opposer has been continuously using the
4 OCOTILLO WELLS mark in connection with the promotion of its events, and the
5 advertising, offering to sell, and selling t-shirts and other event paraphernalia to
6 consumers throughout the United States.

7 10. For at least 30 years, the OCOTILLO WELLS mark has been
8 prominently featured in Opposer's advertising and promotional materials for its
9 TDS Desert Safari event at Truckhaven the North Ocotillo Wells SVRA, and
10 prominently displayed on its banners, promotional flyers, and on t-shirts and other
11 event paraphernalia offered for sale and sold at the event and over the Internet.

12 11. Opposer has received national media acclaim recognizing the high-
13 quality and unique services offered in connection with the OCOTILLO WELLS
14 mark.

15 12. Opposer is active in the promotion and education of off-roading
16 enthusiasts, and in providing a voice to off-roading enthusiasts to legislators and
17 various Federal, State and local government agencies.

18 13. Based on this active promotion, education, and many annual events,
19 the "Tierra Del Sol", "Tierra Del Sol Desert Safari", "TDS", and "TDS Desert
20 Safari", "TDS Truckhaven", and "TDS Ocotillo Wells" have all become
21 synonymous with Opposer.

22 14. Because of Opposer's long use and extensive advertising and
23 promotion of the OCOTILLO WELLS mark, the mark has come to be and is now
24 recognized and relied upon by the trade and public as identifying the goods and
25 services of Opposer and distinguishing them from others.

26 15. The OCOTILLO WELLS mark is distinctive and represents a
27 valuable goodwill and reputation belonging exclusively to Opposer.

28 16. Opposer has become widely known as a user of the OCOTILLO
WELLS mark through its use in conjunction with the annual Tierra Del Sol Desert
Notice of Opposition

1 Safari.

2 17. Over the past 50 years of the Tierra Del Sol Desert Safari, held in
3 Truckhaven in the North Ocotillo Wells SVRA, Opposer has become widely
4 known as the only nationally recognized four wheel drive event.

5 18. These events are widely known and recognized by the “Tierra Del
6 Sol”, “Tierra Del Sol Desert Safari”, “TDS”, and “TDS Desert Safari” marks, used
7 in conjunction with Truckhaven, and Ocotillo Wells, as these events are hosted in
8 Southern California at the Truckhaven Hills area of the North Ocotillo Wells
9 SVRA.

10 19. Applicant has become aware of Opposer’s Tierra Del Sol Desert
11 Safari events in Truckhaven, in the North Ocotillo Wells SVRA, and all of the
12 various marks associated therewith.

13 20. Applicant has previously attended Opposer’s Tierra Del Sol Desert
14 Safari events in Truckhaven, in the North Ocotillo Wells SVRA.

15 21. Applicant has previously sold t-shirts bearing the “Tierra Del Sol”,
16 “Tierra Del Sol Desert Safari”, “TDS”, and “TDS Desert Safari” marks in hopes of
17 misleading unwary customers into purchasing Applicant’s products believing that
18 there is an affiliation, sponsorship, or association between Opposer and Applicant.

19 22. Opposer has previously requested that Applicant cease any use of the
20 Tierra Del Sol, Tierra Del Sol Desert Safari, TDS, and TDS Desert Safari marks.

21 **Applicant’s Improper Use of the OCOTILLO WELLS Mark**

22 23. On March 22, 2013, Applicant applied to register the mark
23 “OCOTILLO WELLS” covering “hats; headwear; hooded sweatshirts; jackets;
24 shirts; sweatshirts; tank-tops,” U.S. Trademark Application Serial No. 85/899999.

25 24. Applicant alleges she has been using the OCOTILLO WELLS mark
26 in connection with the advertisement and sale of hats, headwear, hooded
27 sweatshirts, jackets, shirts, sweatshirts, and tank-tops to consumers throughout the
28 United States.

25. The goods allegedly offered by Applicant under the OCOTILLO
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1 WELLS mark are closely and naturally related to the goods and services offered
2 and sold by Opposer in connection with Opposer's OCOTILLO WELLS mark and
3 its annual event in Truckhaven, California at the North Ocotillo Wells SVRA.

4 26. Opposer never consented to or authorized Applicant's use of the
5 OCOTILLO WELLS mark.

6 27. Applicant's unauthorized use of the OCOTILLO WELLS mark is
7 likely to confuse and deceive consumers into thinking that the goods offered
8 thereunder by Applicant are affiliated with, authorized or sponsored by, or
9 connected with Opposer or Opposer's goods and services.

10 28. Upon information and belief, Applicant's unauthorized uses of
11 Opposer's OCOTILLO WELLS mark is intentional and with deliberate disregard
12 for Opposer's long established prior rights in the OCOTILLO WELLS mark.

13 29. Applicant's continued unauthorized uses of Opposer's OCOTILLO
14 WELLS mark constitute an ongoing threat to Opposer and the public in general.

15 30. Applicant's continued unauthorized uses of Opposer's OCOTILLO
16 WELLS mark dilutes Opposer's rights in the mark.

17 **COUNT ONE**

18 **Priority and Likelihood of Confusion under 15 U.S.C. § 1052(d)**

19
20 31. Opposer incorporates herein by reference each and every allegation in
21 the preceding paragraphs.

22 32. For over 50 years, Opposer has been continuously using the
23 OCOTILLO WELLS mark in commerce in connection with advertising,
24 organizing, producing, and hosting four wheeling events in the North Ocotillo
25 Wells SVRA area of Southern California.

26 33. For more than 30 years, Opposer has been continuously using the
27 OCOTILLO WELLS mark in commerce for t-shirts and other event paraphernalia
28 in connection with its TDS Desert Safari event at the North Ocotillo Wells SVRA.

1 34. Opposer began using, and has continuously used, the OCOTILLO
2 WELLS mark in commerce for t-shirts and other event paraphernalia, and outdoor
3 four wheeling events, long prior to any date of first use upon which Applicant can
4 rely. Specifically, whereas Opposer has been continuously using the OCOTILLO
5 WELLS mark in commerce for over 50 years, Applicant is alleged to have begun
6 using the mark in commerce as of 2002 only.

7 35. For over 50 years Opposer has acquired and maintained significant
8 common law interests and rights in and to the term OCOTILLO WELLS for t-
9 shirts and event-related paraphernalia and outdoor four wheeling events.

10 36. Upon information and belief, Applicant advertises and sells her goods
11 to the same or similar consumers of Opposer's goods and services, and through the
12 same or similar channels of trade as used by Opposer to advertise, offer, sell and
13 render its goods and services under the OCOTILLO WELLS mark.

14 37. In fact, Applicant has, in prior years, set up a t-shirt shop in a road-
15 side trailer adjacent Opposer's off-road events in hopes of snatching t-shirt and
16 other products sales from unwary registrant's of Opposer's events.

17 38. These activities of Applicant have resulted in the dilution of
18 Opposer's rights to the OCOTILLO WELLS mark.

19 39. When applied to the goods set forth in Applicant's application, Serial
20 No. 85/899999, Applicant's OCOTILLO WELLS mark so resembles Opposer's
21 OCOTILLO WELLS mark as to likely cause confusion, mistake or deception
22 within the meaning of Section 2(d) of the Trademark Act.

23 40. When applied to the goods set forth in Applicant's application, Serial
24 No. 85/899999, Applicant's use and the registration of the OCOTILLO WELLS
25 mark will likely confuse and deceive consumers into thinking that Applicant's
26 goods are affiliated with, authorized or sponsored by, or connected with Opposer
27 and Opposer's goods and services.

28 41. Opposer will be damaged by the registration sought by Applicant
because such registration will support and assist Applicant's continued and
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misleading use of the OCOTILLO WELLS mark and would give the color of exclusive statutory right to Applicant in violation and derogation of the prior superior rights of Opposer.

42. In addition, Opposer will be damaged by the registration sought by Applicant in that any subsequent application by Opposer for federal trademark registration of OCOTILLO WELLS for t-shirts and event paraphernalia and outdoor family four wheeling events will likely be refused by the Trademark Office due to the similarities of the parties' marks and the relatedness of the respective parties' goods and services.

43. Further, Opposer will also be damaged by the registration sought by Applicant in that any subsequent use by Opposer of the OCOTILLO WELLS mark for goods and services offered in connection with Opposer's annual TDS Desert Safari event in the Truckhaven Hills area the North Ocotillo Wells SVRA of Southern California may wrongfully subject Opposer to liability for infringement and related claims.

44. Given Opposer's longstanding and prior trademark rights in the OCOTILLO WELLS mark for t-shirts and event paraphernalia and outdoor family four wheeling events, any federal trademark registration for "OCOTILLO WELLS," including Applicant's application, conferring exclusive, nationwide rights would be improper and would directly interfere with Opposer's prior rights in the OCOTILLO WELLS mark.

COUNT TWO

Applicant's Mark is Merely Descriptive

45. Opposer incorporates herein by reference each and every allegation in the preceding paragraphs.

46. Applicant and Opposer are competitors in the t-shirt business in Ocotillo Wells, California.

1 47. The OCOTILLO WELLS mark has been used by numerous other
2 third parties, including Opposer, prior to Applicant's application for trademark
3 registration.

4 48. The OCOTILLO WELLS mark has been used by numerous other
5 third parties, including Opposer, prior to Applicant's date of first use alleged in her
6 application for trademark registration.

7 49. Based on this third party usage of OCOTILLO WELLS prior to
8 Applicant's date of application and alleged date of first use, Applicant is not
9 entitled to a presumption of secondary meaning under Section 2(f) of the
10 Trademark Act.

11 50. Applicant's OCOTILLO WELLS mark has not achieved secondary
12 meaning.

13 51. Applicant's OCOTILLO WELLS mark is incapable of achieving
14 secondary meaning due to the third party use of the word "ocotillo wells" on or in
15 conjunction with clothing long prior to any alleged use by Applicant.

16 52. Applicant's OCOTILLO WELLS mark is merely descriptive as
17 applied to goods or services provided or delivered in Ocotillo Wells, California.

18 **COUNT THREE**

19 **Applicant's Mark is Generic**

20 53. Opposer incorporates herein by reference each and every allegation in
21 the preceding paragraphs.

22 54. The OCOTILLO WELLS mark has been used by numerous other
23 third parties, including Opposer, prior to Applicant's application for trademark
24 registration.

25 55. The OCOTILLO WELLS mark has been used by numerous other
26 third parties, including Opposer, prior to Applicant's date of first use alleged in her
27 application for trademark registration.

28 56. Based on this third party usage of OCOTILLO WELLS prior to
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1 Applicant's date of application and alleged date of first use, on or in connection
2 with similar goods and services in the same geographic region, Applicant's
3 OCOTILLO WELLS mark has not achieved secondary meaning.

4 57. Applicant's OCOTILLO WELLS mark is incapable of achieving
5 secondary meaning due to the third party use of the word "ocotillo wells" on or in
6 conjunction with clothing long prior to any alleged use by Applicant.

7 58. Applicant's OCOTILLO WELLS mark is generic as applied to goods
8 or services provided or delivered in Ocotillo Wells, California.

9 **COUNT THREE**

10 **Applicant's Mark is Geographically Descriptive**

11
12 59. Opposer incorporates herein by reference each and every allegation in
13 the preceding paragraphs

14 60. Ocotillo Wells Ocotillo Wells is an unincorporated community in San
15 Diego County, California. It is 3 miles (4.8 km) west of the Imperial County line
16 on State Route 78 at an elevation of 163 feet (50 m).¹

17 61. A map showing Ocotillo Wells, California is attached as Exhibit 1.

18 62. Opposer is keenly involved in the Truckhaven area of the North
19 Ocotillo Wells SVRA as that area is one of only a few remaining off-road vehicle
20 areas using public lands.

21 63. A photograph showing Opposer's affiliation with the Truckhaven area
22 in the North Ocotillo Wells SVRA as presented in the California State Parks
23 "TRUCKHAVEN 4X4 TRAINING AREA" sign as proudly sponsored by
24 Opposer, is shown in Exhibit 2.

25 64. A photograph showing Opposer's affiliation with Truckhaven and the
26 Ocotillo Wells SVRA as presented in the California State Parks "WELCOME TO
27 TRUCKHAVEN" sign as proudly sponsored by Opposer is shown in Exhibit 3.

28 ¹ http://en.wikipedia.org/wiki/Ocotillo_Wells
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1 65. A photograph showing Opposer's affiliation with the California State
2 Parks in and around the Truckhaven and Ocotillo Wells area as presented in the
3 California State Parks "An Oasis for Life" sign as proudly sponsored by Opposer is
4 shown in Exhibit 4.

5 66. Opposer and the California State Parks have worked, and continue to
6 work, to preserve the public lands in and about the Ocotillo Wells and Truckhaven
7 regions of Southern California.

8 67. Through this work, Opposer has become widely recognized as the
9 champion of the off-road enthusiasts interests in preserving the public lands for
10 generations to come, and has received accolades and public recognition for its
11 efforts.

12 68. Applicant's use of the OCOTILLO WELLS mark in conjunction with
13 providing goods in Ocotillo Wells, California is geographically descriptive.

14 69. Applicant's use of the OCOTILLO WELLS mark in conjunction with
15 providing goods in Ocotillo Wells, California, is not unique as others have done
16 the same prior to Applicant's alleged dates of first use.

17 70. Registration of Applicant's OCOTILLO WELLS application would
18 allow Applicant to get immediate exclusive rights in a geographic designation that
19 other companies have consistently used, legitimately need, and creates an unlawful
20 burden on competitors within the geographic region of Ocotillo Wells, California.

21 71. Applicant's OCOTILLO WELLS mark is thus incapable of trademark
22 protection.

23 **COUNT FOUR**

24 **Applicant's Use of the OCOTILLO WELLS mark is Purely Ornamental**

25 72. Opposer incorporates herein by reference each and every allegation in
26 the preceding paragraphs.

27 73. The specimens submitted in conjunction with Applicant's trademark
28 Notice of Opposition

1 application depict the “ocotillo wells” mark on the front of shirt and is purely
2 ornamental, and fails to identify a source of goods or services.

3 74. The use of “ocotillo wells” on Applicant’s specimen does not indicate
4 a unique source of goods.

5 75. The use of “ocotillo wells” on Applicant’s specimen is ornamental as
6 is typical for any and all uses of the mark OCOTILLO WELLS on clothing.

7 76. Applicant’s mark as used on the specimen of record (1) is merely a
8 decorative or ornamental feature of applicant’s clothing; and (2) does not function
9 as a trademark to indicate the source of applicant’s clothing and to identify and
10 distinguish applicant’s clothing from others.

11 **COUNT FIVE**

12 **Applicant Engaged In Fraud On The Trademark Office**

13
14 77. Opposer incorporates herein by reference each and every allegation in
15 the preceding paragraphs.

16 78. Applicant is well aware of Opposer’s use of the word “ocotillo wells”
17 in conjunction with its annual event at Ocotillo Wells, California, and with various
18 clothing products provided in conjunction with the event.

19 79. Applicant’s statement in the Trademark Application that the
20 statement:

21 “...she believes the applicant to be the owner of the trademark/service
22 mark sought to be registered, or, if the application is being filed under
23 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to
24 use such mark in commerce; to the best of his/her knowledge and
25 belief no other person, firm, corporation, or association has the right
26 to use the mark in commerce, either in the identical form thereof or in
27 such near resemblance thereto as to be likely, when used on or in
28 connection with the goods/services of such other person, to cause
confusion, or to cause mistake, or to deceive...”

were knowingly false, and Applicant was aware of the falsity of that statements at
Notice of Opposition

1 the time the Trademark Application was filed.

2 80. Applicant is not the owner of the OCOTILLO WELLS mark.

3 81. Applicant knowingly misrepresented that she is the owner of the mark
4 sought to be registered.

5 82. Applicant is aware of other parties, including Opposer, that have the
6 right to use the Ocotillo Wells mark in commerce.

7 83. Applicant knowingly misrepresented that to the best of her knowledge
8 and belief, no other person, firm, corporation, or association has the right to use the
9 mark in commerce, either in identical form thereof or in such near resemblance
10 thereto as to be likely, when used on or in connection with the goods/services of
11 such other person, to cause confusion, or to cause mistake, or to deceive.

12 84. Applicant knowingly misrepresented that all statements made of her
13 own knowledge are true;

14 85. Applicant knowingly misrepresented that all statements made on
15 information and belief are believed to be true.

16 86. Applicant's date of first use anywhere as alleged in the Trademark
17 Application is false.

18 87. Applicant's date of first use in commerce as alleged in the Trademark
19 Application is false.

20
21 **WHEREFORE**, Opposer prays that this Notice of Opposition be sustained in
22 favor of Opposer, Application Serial No. 85/899999 be rejected, and no
23 registration be issued thereon to Applicant.

24 Dated: January 8, 2014

GARY L. EASTMAN, APLC

25 By: /s/ Gary L. Eastman

Gary. L. Eastman, Esq.

26
27 Attorney for Opposer
28 TIERRA DEL SOL FOUR WHEEL DRIVE
CLUB

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I am over the age of eighteen years and not a party to this action. My business address is 401 West A Street, Suite 1785, San Diego, California, 92101, which is located in the county where the service described below took place.

NOTICE OF OPPOSITION

XM@SECUREYOURTRADEMARK.COM

I certify and declare under penalty of perjury under the laws of the United States and the State of California that the foregoing is true and correct.

GARY L. EASTMAN, APLC

By: /s/ Gary L. Eastman

Gary. L. Eastman, Esq.

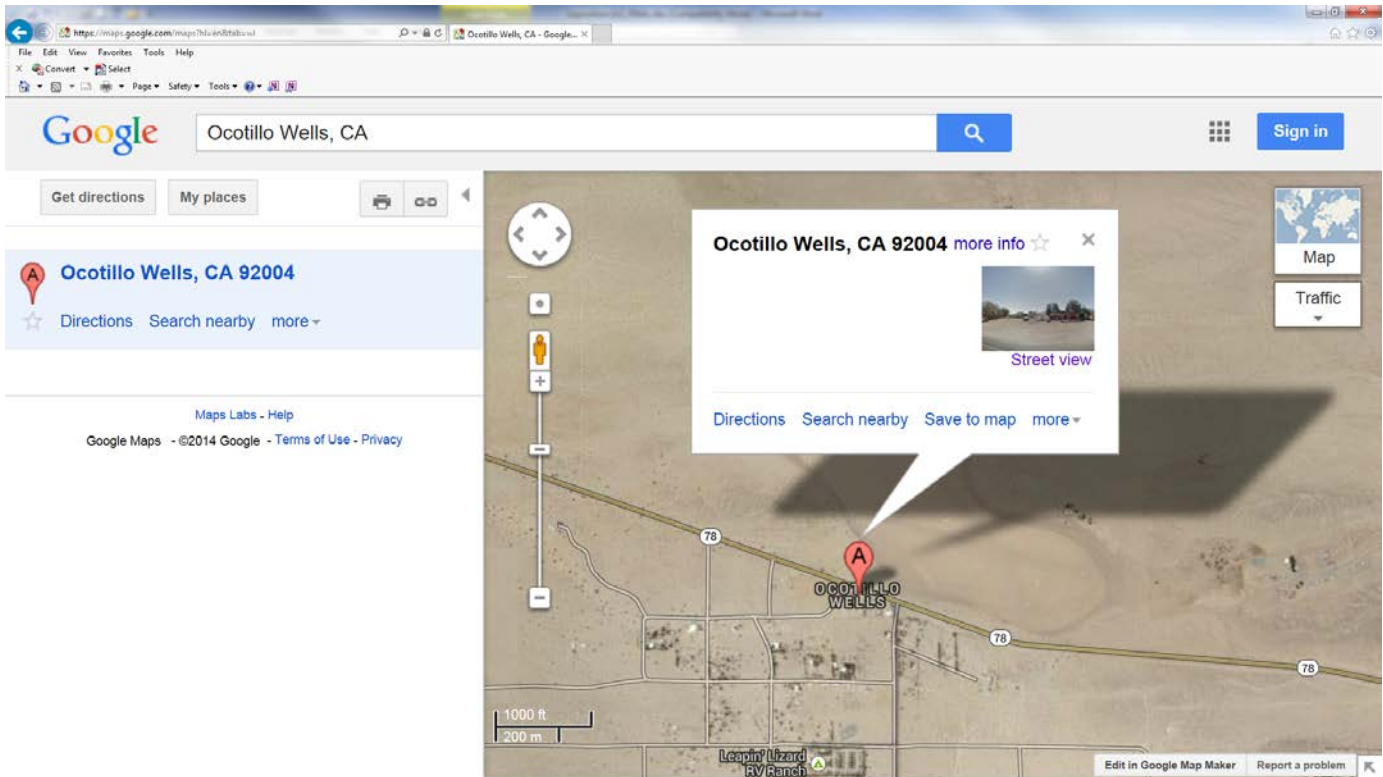


Exhibit 1



Exhibit 3

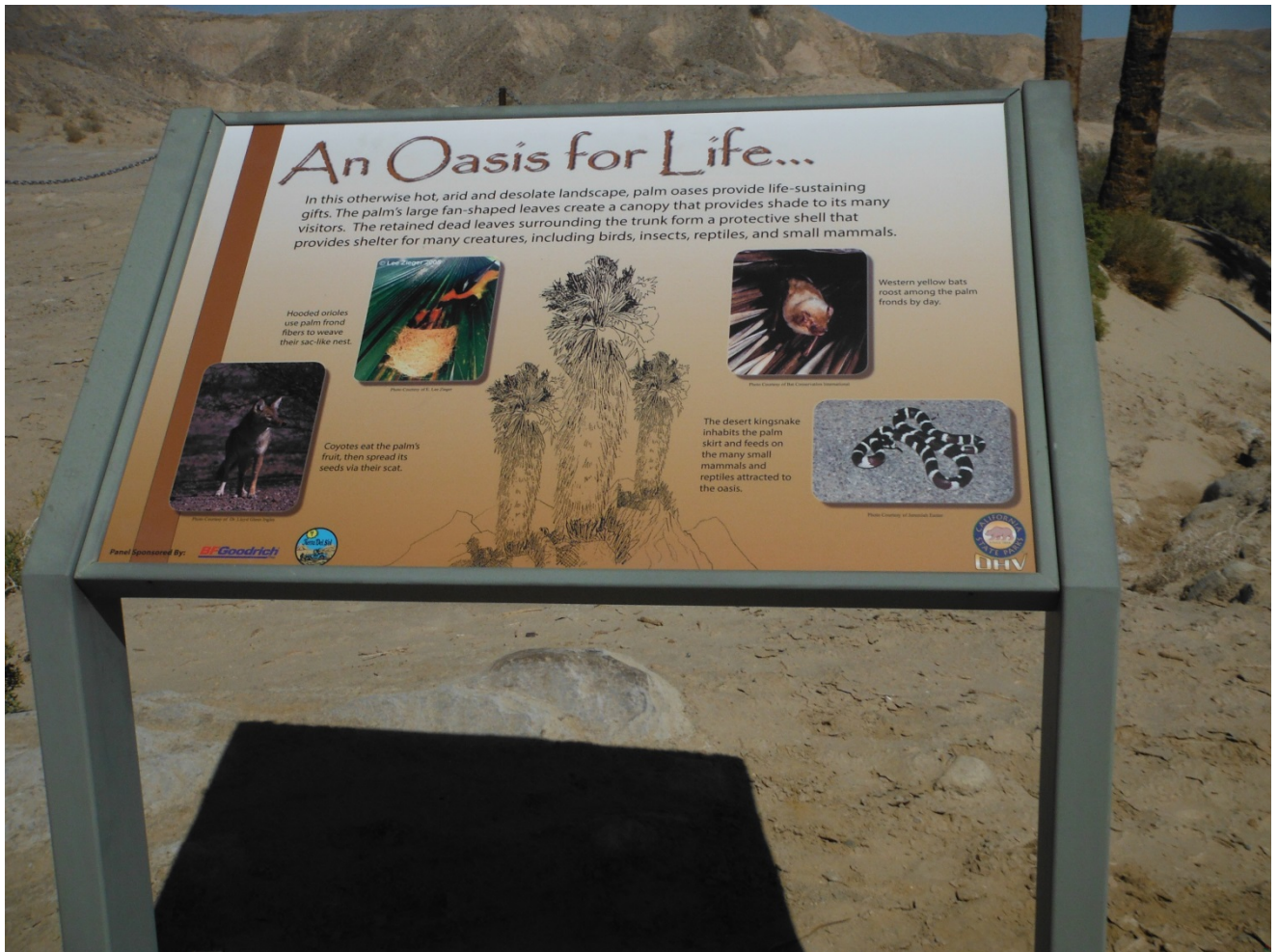


Exhibit 4